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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,031	09/25/2006	Kenji Shiga	12477/13	4637
23838 7590 11/09/2010 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER				
JONES JR., ROBERT STOCKTON				
ART UNIT		PAPER NUMBER		
1762				
MAIL DATE		DELIVERY MODE		
11/09/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/594,031

Applicant(s)

SHIGA ET AL.

Examiner

ROBERT JONES

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 October 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/JAMES SEIDLECK/
Supervisory Patent Examiner, Art Unit 1765

/R. J./
Examiner, Art Unit 1762

Continuation of Box 11.

I. Rejection of Claims 17-21 and 23-29 under 35 USC 103(a) over Shiga et al

The Applicant argues that the claimed invention is not obvious over Shiga because the Declaration under 37 CFR 1.132 demonstrates unexpected results.

The Declaration includes data for 3 examples and 3 comparative examples. Results are presented for only 3 amorphous polyesters (I), only 2 reactive compounds (II), only one amorphous polyester resin (III), and only two crystalline polyester resins (IV). In contrast, the claims are drawn to ANY amorphous polyester, ANY reactive compound containing two or more glycidyl and/or isocyanate groups, ANY amorphous polyester, and ANY crystalline polyester resin.

The examples are carried out as described in the specification. While the declaration asserts that only a portion of functional groups on the reactive compound were reacted with the amorphous polyester, this is not supported by any sort of data, characterization, etc. The more detailed procedure, appearing in the specification at p. 22, lines 17-25, does not mention any sort of partial reaction, and would not lead one of ordinary skill in the art to suspect that an incomplete reaction had occurred.

The examples include component (I) in the amount of either 27 or 20 parts; component (II) in the amount of 3 or 10 parts; component (III) in the amount of 70 parts; and component (IV) in the amount of 70 parts. In contrast, the claims do not require the components to be present in a specific amount, and therefore presumably allow each component to be present in any amount.

Thus, for the reasons specified above, the results presented in the Declaration are not commensurate in scope with the claims, and cannot be relied upon to establish non-obviousness.

Additionally, it is noted that the data presented in the Declaration is not specific enough to allow one of ordinary skill in the art to determine the significance of the results. Each data point is represented by a symbol which covers a wide range of values, rather than a single numerical value. For example, in measuring surface smoothness, a circle indicates a maximum height of an irregular plane less than 100 micrometers, while a triangle represents a maximum height of 100 micrometers or more (see specification, p. 24, lines 13-14). Thus, a value of 0.999 micrometers would be represented by a circle, while a value of 100.000 micrometers would be represented by a triangle. The symbolic data presented in the Declaration would give the appearance that the difference in the two was quite significant, while in practice, the two only differ by 0.001 micrometer. The absence of numerical data makes it impossible for one of ordinary skill in the art to determine the significance of the results.

II. Rejection of Claims 7-11, 13-15, 25-29, and 31-33 over Avramova in view of Akira

The Applicant argues that in the invention of Claims 7 and 25, the amorphous polyester (I) and the amorphous polyester resin (III) are not only mixed together, but have different effects. The Applicant states that (I) is a component of the modifier and is first reacted with reactive compound (II) to obtain a modifier, and that the resultant modifier is thereafter added to amorphous polyester resin (III).

The Applicant's arguments are drawn to features which are not a part of the claims as currently drafted. The claims do not require any sort of pre-mixing or pre-reaction of components (I) and (II). The claims merely require a composition comprising (I), (II), and (III), wherein some portion of (II) is reacted with (I). The claims do not exclude (II) reacting simultaneously with (I) and (III), and do not require formation of any sort of modifier as per the Applicant's arguments.

The Applicant argues individually against the reference to Avramova and Akira, concluding that because neither reference teaches all elements of the claims, the combination of the two does not render the claims obvious. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant again argues that the results presented in the accompanying Declaration demonstrate evidence of non-obviousness. However, for the reasons set forth above, the Declaration cannot be relied upon in establishing non-obviousness of the claims.

III-IV. The Applicant presents no further specific arguments regarding the rejection under 35 USC 103(a) of Claims 12, 16, 30, and 34 over Avramova in view of Akira and Borman, or Claim 22 over Shiga in view of Borman.